

II. REMARKS/ARGUMENTS

These Remarks are in response to the Office Action mailed July 12, 2005. No fee is due for the addition of any new claims.

Claims 1, 4, 8, and 10-20 were pending in the Application prior to the outstanding Office Action. The Office Action rejected claims 1, 4, 8, and 10-20. The present response includes an affidavit antedating a cited prior art reference, leaving for the Examiner's present consideration claims 1, 4, 8, and 10-20. Reconsideration of the rejections is respectfully requested.

Point 8.

Claims 1, 4, 11-12 and 14-20 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Stifelman, et al.*, "The Audio Notebook, Paper and Pen Interaction with Structured Speech," SIGCHI's 01, March 31-April 4, 2001, vol. 3, iss. 1, ACM 2001, pages 182-189 (hereafter, "*Stifelman*") in view of *Arons et al.*, U.S. Pat No. 6,529,920 (hereafter, "*Arons*").

The Applicant herein supplies the declaration of Dr. Patrick Chiu. In the declaration, Dr. Chiu states that he is an employee of Fuji Xerox Palo Alto Laboratories, and specializes in computer software development. (Chiu declaration, ¶3). Dr. Chiu, is an inventor of U.S. patent application 09/843,197. (Chiu declaration, ¶5). Dr. Chiu co-designed a prototype of the invention which included all elements of claim 1 of the U.S. patent application. (Chiu declaration, ¶6 and ¶7). The prototype used the computer programs "LiteMinutes.java" and "DataStore.exe", which were compiled prior to March 31, 2001 (Chiu declaration, ¶12-14). Dr. Chiu identifies "Exhibit A", "Exhibit B" and "Exhibit C" as computer file listings showing the computer programs "LiteMinutes.java", "DataStore.dsp" and "DataStore.exe" respectively, which are submitted as factual evidence of the correctness of the declaration (Chiu declaration, ¶9-11). Further, in the declaration, Dr. Chiu declares under penalty of perjury that the prototype embodiment of the invention was demonstrated to an internal Fuji Xerox Palo Alto Laboratories research and development team. (Chiu declaration, ¶15-17). As such, this co-inventor is able to establish actual reduction to practice of this invention prior to the effective date of the *Stifelman* reference. Therefore, the *Stifelman* reference is not available to

be combined with *Arons*. The Applicant respectfully requests that the Examiner reconsider this rejection.

Point 9.

Claim 8 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Stifelman in view of *Arons* and further in view of Davis et al., "Notepals: Lightweight Note Sharing by the Group, for the Group," ACM 1999, pages 338-345 (hereafter, "Davis").

As discussed above, the Applicant has shown that *Stifelman* is neither anticipatory nor prior art to the Applicants invention and as such is not available to be combined with *Arons* and *Davis*. The Applicant requests that the Examiner reconsider this rejection.

Point 10.

Claims 10 and 13 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Stifelman in view of *Arons* and *Davis* and further in view of Mora et al. (U.S. Pat No. 6,161,113).

As discussed above, the Applicant has shown that *Stifelman* is neither anticipatory nor prior art to the Applicants invention and as such is not available to be combined with *Arons*, *Davis* and *Mora*. The Applicant requests that the Examiner reconsider this rejection.

III. CONCLUSION

The references cited by the Examiner but not relied upon have been reviewed, but are not believed to render the claims unpatentable, either singly or in combination.

In light of the above, it is respectfully submitted that all remaining claims, as amended in the subject patent application, should be allowable, and a Notice of Allowance is requested.

The Examiner is respectfully requested to telephone the undersigned if he can assist in any way in expediting issuance of the patent.

No fee is believed due in connection with this paper. However, the Commissioner is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 06-1325 for any matter in connection with this response, including any fee for extension of time, which may be required.

Dated: 10/12/05

Respectfully submitted,

By: 

Anthony G. Craig
Registration No. 50,342

FLIESLER MEYER LLP
Four Embarcadero Center, Fourth Floor
San Francisco, California 94111-4156
Telephone: (415) 362-3800
Facsimile: (415) 362-2928
e-mail: acraig@fdml.com
Customer No.: 23910